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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

IMPINJ, INC.,

Case No. 4:19-cv-03161-YGR-VKD

Plaintiff,

**[PROPOSED] JOINT PRETRIAL
CONFERENCE STATEMENT**

v.

NXP USA, INC.,

Defendant.

Date: March 18, 2024

Time: 8:00 a.m.

Location: Courtroom 1, 4th Floor

Judge: Hon. Yvonne Gonzalez Rogers

1 Pursuant to Section 2 of the Court's Standing Order re: Pretrial Instructions in Civil Cases
 2 (updated December 21, 2023), Plaintiff Impinj, Inc. ("Impinj") and Defendant NXP USA, Inc.
 3 ("NXP") (collectively, the "Parties") hereby submit this Joint Pretrial Conference Statement.

4 **I. THE ACTION**

5 **A. The Parties**

6 The Parties to this action are Impinj, Inc., a Delaware corporation with its principal place
 7 of business at 400 Fairview Avenue North, Seattle, Washington 98109, and NXP USA, Inc., a
 8 Delaware corporation with its principal place of business at 6501 William Cannon Drive West,
 9 Austin, Texas 78735.

10 **B. Substance of the Action**

11 This is an action for patent infringement, and the jurisdiction of the Court arises under the
 12 Patent Act, 35 U.S.C. § 271 et seq. The Court has original jurisdiction over this controversy
 13 pursuant to 27 U.S.C. §§ 1331 and 1338(a). Jurisdiction, venue, and Impinj's standing to bring
 14 this suit are not disputed. The issues of infringement, willful infringement and damages (through
 15 the earlier trial and motion practice) have already been decided.¹ The upcoming trial relates
 16 solely to NXP's affirmative defense that claims 1, 3, 4, and 7 of U.S. Patent No. 9,633,302 (the
 17 "302 patent") are invalid as obvious.

18 **1. The Parties Claims**

19 The jury returned a verdict in the earlier trial that NXP has directly infringed claims 1, 12,
 20 and 15 of U.S. Patent No. 8,115,597 (the "597 patent")², and claims 1, 3, 4, and 7 of U.S. Patent
 21 No. 9,633,302 (the "302 patent") (collectively, the "Asserted Patents") and that such
 22 infringement of the '302 patent was willful. Infringement of the '302 patent was based on NXP's
 23 sales of the following integrated circuits:

24

- 25 • UCODE 8, UCODE 8m, and UCODE 9 products infringes claims 1, 3, 4, and

26 ¹ NXP preserves all rights to appeal the Court's summary judgement ruling of infringement with
 27 respect to the '302 patent as well as the jury verdict with respect to willful infringement and
 damages.

28 ² NXP preserves all rights to appeal the jury verdict with respect to the '597 patent.

7 of the '302 patent.

The upcoming trial is limited to a NXP's affirmative defense and counterclaim that claims 1, 3, 4, and 7 of U.S. Patent No. 9,633,302 (the “302 patent”) are invalid as obvious³.

2. Relief Requested

Impinj seeks dismissal of NXP's affirmative defense of obviousness. NXP seeks a declaratory judgment that all asserted claims of the '302 patent are invalid as obvious.

II. THE FACTUAL BASIS OF THE ACTION

A. Undisputed Facts

The parties stipulate to the facts contained in each party's statement of undisputed material facts that the responding party confirmed was undisputed. The parties also stipulate to the following facts for incorporation into the trial record without the necessity of supporting testimony or exhibits:

1. Impinj is a Delaware corporation with its principal place of business at 400 Fairview Avenue North, Seattle, Washington 98109.

2. NXP is a Delaware corporation, with a principal place of business at 6501 William Cannon Drive West, Austin, Texas 78735.

3. NXP is an indirect subsidiary of NXP B.V.

4. NXP was acquired by NXP B.V. via acquisition from Freescale Semiconductor Inc. in December 2015.

5. Impini is the owner of the Asserted Patents.

⁷ The '302 patent was filed on March 31, 2015.

⁸ The '202 patent has a priority date of March 31, 2015.

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³ It is Impinj's position that the upcoming trial is limited to NXP's affirmative defense the asserted claims of the '302 patent are invalid as obvious over the combination of Eberhardt and Ching-San, the only combination NXP raised at the prior trial.

1 11. Impinj accused NXP of infringing the '302 patent by letter dated October
 2 6, 2017.

3 **B. Disputed Facts**

4 1. Whether NXP has proven, by clear and convincing evidence, that one or more of claims 1,
 5 3, 4, and 7 of the '302 patent are invalid.

6 2. Whether long-felt need for the claimed inventions, copying, licensing, praise, industry
 7 recognition and commercial success rebut any *prima facie* case of obviousness.⁴

8 3. The skill level a person of ordinary skill in the art would have for the '302
 9 patent.

10 **C. Agreed Statement**

11 This action is not suitable for presentation upon an agreed statement of facts, except as
 12 stated above under the Undisputed Facts.

13 **D. Stipulations**

14 **1. Stipulated Motion *in Limine*⁵**

15 In an effort to avoid motion practice, the parties have agreed that Impinj will not introduce
 16 evidence of the PTAB decision rejecting NXP's petition for inter partes review of the '302 patent
 17 unless NXP introduces evidence or argument that warrants such introduction. The parties have
 18 also agreed they will not reference the other lawsuits (including the '597 patent litigation, the
 19 Washington or the Waco lawsuits) unless either party introduces evidence or argument that
 20 warrants such introduction.

21 **2. Proposed Order on Stipulations Re: Conduct of Trial**

22 The parties have agreed to a number of stipulations concerning certain trial disclosures.
 23 These stipulations will be included in a Proposed Order on Stipulations Re: Conduct of Trial to

24 ⁴ It is NXP's position that Impinj never properly disclosed during discovery that it intended to rely
 25 on long-felt need, copying or licensing as secondary considerations of non-obviousness. In
 26 response to an interrogatory on this point, Impinj only identified commercial success and industry
 27 praise as secondary considerations of non-obviousness, and Impinj should be precluded from eliciting
 28 testimony, evidence, or argument that any other secondary consideration supports non-obviousness.

⁵ The Court granted Impinj's motion to strike Dr. van der Weide's opinions concerning prosecution
 history disclaimer. Dkt. No. 339 at 20-21. Impinj understands that Dr. van der Weide and NXP
 will not be offering opinions on this issue during trial.

1 be filed with the Trial Readiness Binder.

2 **III. DISPUTED LEGAL ISSUES**

3 The following are disputed issues of law to be addressed or determined by the Court:

4 1. Whether NXP cannot prove, as a matter of law, that the asserted claims of the '302 patent
5 are obvious under 35 U.S.C. § 103.

6 **IV. FURTHER DISCOVERY OR MOTIONS**

7 The Parties do not have any discovery remaining or any discovery motions pending.

8 **V. ESTIMATE OF TRIAL TIME**

9 Pursuant to the Court's November 3, 2023 Pretrial Order No. 1A Re: Re-trial Date (Dkt.
10 486), the parties understand that the Court will allot 8 hours of trial time to each party during a
11 trial beginning March 18, 2024, at 8:00 AM, and ending approximately on March 21-22, 2023.

12 Pursuant to the Court's Standing Order Re: Pretrial Instructions in Civil Cases (updated
13 December 21, 2023), the parties understand that the Court's trial day begins at 8:00 AM and ends
14 at 1:40 PM with two 20-minute breaks, totaling 5 hours per trial day. Accordingly, the parties
15 understand that, following jury selection, the parties will divide the remaining time evenly.

16 **VI. PENDING MOTIONS BEFORE THE COURT**

17 There are no motions pending with the Court other than motions in limine.

18 **VII. MOTIONS IN LIMINE**

19 NXP filed the following motions in limine:

20 • NXP USA, Inc.'s Motion in Limine No. 1 to Preclude Impinj From
21 Introducing Evidence of "Copying" Including Product "Teardowns"
22 • NXP USA, Inc.'s Motion in Limine No. 2 to Preclude Impinj From Eliciting
23 Evidence or Argument Regarding the Court's Finding of Infringement
24 • NXP USA, Inc.'s Motion in Limine No. 3 to Preclude Impinj Referencing the
25 Size, Wealth, or Number of Employees of Either Impinj or NXP
26 • NXP USA, Inc.'s Motion in Limine No. 4 to Preclude Impinj From Referring

1 to the '302 Patent as the Enduro Patent (**Mooted through resolution by the**
 2 **parties.**)

3 • NXP USA, Inc.'s Motion in Limine No. 5 Seeking an Order that Impinj
 4 Should not be Permitted to Tell the Jury that the '302 Patent is Entitled to a
 5 Presumption of Validity

6 Impinj filed the following motions in limine:

7 • Impinj's Retrial Motion In Limine No. 1 Seeking Preclusion of Evidence
 8 Relating to HITAG

9 **VIII. JUROR QUESTIONNAIRE AND ADDITIONAL QUESTIONS FOR JURY *VOIR*
 10 *DIRE***

11 Impinj and NXP previously filed proposed additional questions to include in the jury
 12 questionnaire. Impinj and NXP also previously filed additional questions for jury voir dire.
 13 These will be included in the trial readiness binder submitted to the Court.

14 **IX. TRIAL ALTERNATIVES AND OPTIONS**

15 **A. Settlement Discussion**

16 The Parties have engaged in settlement discussions, which have been unsuccessful.
 17 Further negotiations are not likely to be productive at this time.

18 **B. Consent to Trial Before a Magistrate Judge**

19 The parties do not consent to trial before a Magistrate Judge for all or part of this action.

20 **C. Bifurcation, Separate Trial of Issues**

21 Neither party desires bifurcation or separate trial of specific issues. The parties
 22 understand that the Court intends to bifurcate the invalidity trial from any hearing regarding
 23 remedies, including injunction.

1 **X. NXP'S STATEMENT OF LEGAL POSITION AND PRESERVATION FOR**
 2 **APPEAL REGARDING CERTAIN CLAIM CONSTRUCTION ISSUES**

3 **A. '302 Patent: "separated" and "the channel is shaped to facilitate a fluid flow**
 4 **from the center to the first and second ends"**

5 **1. NXP's Position**

6 For clarity and in an abundance of caution, NXP provides notice that it preserves all of its
 7 objections to the Court's Claim Construction Orders (Dkts. 102, 130) regarding terms for which
 8 the Court did not adopt NXP's proposed constructions. *See O2 Micro Intl. Ltd. v. Beyond*
 9 *Innovation Tech. Co.*, 521 F.3d 1351, 1359 (Fed. Cir. 2008) (where an issue was "fully litigated
 10 and decided at the Markman stage of the litigation," no further objection to a jury instruction on
 11 claim construction is required)).

12 NXP also preserves its objections to the Court's constructions of the terms "separated"
 13 and "the channel is shaped to facilitate a fluid flow from the center to the first and second ends"
 14 of the asserted claims of U.S. Patent 9,633,302. The parties did not raise these terms to be
 15 construed during claim construction proceedings, and thus their meanings were not decided at
 16 that time. (See Dkts. 102, 130.) Although the Court did not expressly state its construction of
 17 "separated," the Court apparently construed the term's "plain and ordinary meaning" to mean that
 18 "the first and second antenna contacts" can be "separated" even though they are connected. (See,
 19 e.g., Dkt. 339 at 11, 18.) The Court also expressly construed "the channel is shaped to facilitate a
 20 fluid flow from the center to the first and second ends" not to be a substantive limitation that must
 21 be satisfied to prove infringement. (Dkt. 339 at 11, 18.) Accordingly, for purposes of preserving
 22 its rights on appeal, NXP provides notice that it objects to these constructions.

23 **2. Impinj's Position**

24 Impinj does not object to NXP preserving its objections. But Impinj disagrees with
 25 NXP's and its expert's opinions and constructions of the term "separated" as conflicting with the
 26 plain and ordinary meaning of the term, in view of the specification of the '302 patent, for the
 27 reasons stated in Impinj's motion to strike certain opinions of Dr. Subramanian and motion for
 28 summary judgment of infringement of the '302 patent. Impinj also disagrees with NXP's and its
 29 expert's opinions and constructions of the term "the channel is shaped to facilitate a fluid flow

1 from the center to the first and second ends" as conflicting with Federal Circuit precedent for the
2 reasons stated in Impinj's motion to strike certain opinions of Dr. Subramanian and motion for
3 summary judgment of infringement of the '302 patent.

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1 Dated: January 26, 2024.

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3 Attorneys for Defendant
NXP USA, INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served via U.S. District Court CM/ECF notification on January 26, 2024 to all counsel of record.

/s/ Ramsey M. Al-Salam
Ramsey M. Al-Salam